IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant(s):	Andreas Myka et al.	
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Art Unit:	2168	
Examiner:	Jay A. Morrison	
Title:	SYSTEM AND METHOD FOR PROCESSING A PRODUCT PRICE OR QUOTATION REQUEST AND PLACING A PRODUCT ORDER VIA A COMMUNICATIONS PROGRAM	

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REPLY BRIEF UNDER 37 CFR § 41.41

The present Reply Brief is filed in response to the Examiner's Answer with a mailing date of October 9, 2007. The Examiner's Answer maintained all of the outstanding claim rejections. However, in so doing, the Examiner provided several new arguments in an effort to support the outstanding rejections. In response, Applicants respectfully submit the below remarks supporting the patentability of the claims of the present application. Applicants note that silence in the present Reply Brief regarding the patentability of any claim should not be construed as an indication of agreement with respect to any ground of rejection, but merely an indication that Applicants consider the previously presented arguments to be sufficient, which arguments are not repeated herein for the sake of brevity.

I. Correction of "Grounds of Rejection to be Reviewed on Appeal"

In the Appeal Brief filed on June 25, 2007, Applicants reiterated the grounds of rejection provided in the final Official Action. However, while the Official Action characterized the obviousness rejections as follows:

> "Claims 1-13, 34, 36-53, 55, and 57-68 stand rejected under 35 U.S.C. § 103(a) as being obvious over Grosvenor in view of U.S. Patent Application Publication No. 2004/0203797 to Burr ("Burr");"

it appears that the Official Action argues, in fact, that Claims 1-13, **24-33**, 34, 36-53, 55, and 57-68 are actually intended to be rejected as obvious based on the combination of Grosvenor and Burr. Applicants have throughout prosecution (including in the Appeal Brief) presented arguments regarding the patentability over the combination of Grosvenor and Burr of Claims 24-33. Applicants hereby explicitly correct the statement of the "Grounds of Rejection to be Reviewed on Appeal" to read:

> Claims 14-33 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 14-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0021591 to Grosvenor et al. ("Grosvenor"). Claims 1-13, 24-34, 36-53, 55, and 57-68 stand rejected under 35 U.S.C. § 103(a) as being obvious over Grosvenor in view of U.S. Patent Application Publication No. 2004/0203797 to Burr ("Burr").

II. Rejection of Independent Claim 14 Under Section 102

Independent Claim 14, rejected as being anticipated by *Grosvenor*, reads as follows:

> 14.   A method for wireless bonding of devices and communicating media file transfer parameters, the method comprising:
>   monitoring, at a master device, an area of interest for the presence of potential bondable devices;
>   receiving, at the master device, a presence signal from a potential bondable device;
>   determining bond capability of the potential bondable device;
>   approving the potential bondable device as a bonded device; and
>   communicating, from the master device to the bonded device, media file transfer parameters, including definition of the media file metadata that is to be included with a captured media file.

With regard to the rejection of Claim 14, the Examiner's Answer states at pp. 28-9 that "Applicant's argument makes reference to the repository but [Claim 14] does not have any mention of images being deposited or any other language that would indicate that the master device he teaches even acts as a repository . . . In fact, a master device could be interpreted to be any device that contains the transfer parameters, which can be communicated to a bonded device . . ."

However, the Examiner's statement is inaccurate in several ways. First, Applicants' prior arguments pointed out that the Examiner had, in a previous rejection, apparently equated the "master device" of Claim 14 with the "repository" described in *Grosvenor*, and did not in any

way indicate that the claimed master device was required to be a repository. Further, as is clear from reviewing Claim 14, the claimed master device cannot be any device that contains transfer parameters that can be communicated to a bonded device, but must also have the capabilities to allow for the monitoring of an area of interest for the presence of potential bondable devices and the receiving of a presence signal from a potential bondable device, and, ultimately, to bond to a slave device.

The Examiner's Answer continues by citing paragraph 0059 of *Grosvenor* (not previously cited with respect to Claim 14). Paragraph 0059 of *Grosvenor* states:

> "As mentioned above and as shown in FIG. 2, in the preferred embodiment of the invention the synchronisation event comprises the first user's camera **20** generating a synchronisation signal that is transmitted to the cameras **22** of the other users present at the event who intend to share their pictures. The signal includes a synchronisation code, which contains an address code (e.g. a web address) pertaining to the identity and/or location of the repository database, so that each of the synchronised cameras has knowledge of where the pictures are to be sent for sharing, and also the Event ID by which the photographs can be classified in the database repository."

The Examiner's Answer indicates that "the claimed media transfer parameters are taught by the synchronization code by *Grosvenor*, and the definition of media file metadata to be included in the captured media file is the *Grosvenor* event ID." This statement implies that the Examiner is attempting to equate the "first user's camera **20**" with the "master device" of Claim 14. However, the first user's camera **20** cannot be the master device, at least because the first user's camera is at no point "bonded" to any slave devices. It is noted that it is not enough that two devices simply communicate in order to conclude that the devices are bonded. That this is true is clear from examination of Claim 14, where the master device receives a presence signal from (*i.e.*, communicates with) a potential bondable device (*i.e.*, a device that is not yet, and may never be, bonded). However, the first user's camera **20** of *Grosvenor* does nothing more than take part in respective transient communications with other devices.

Further, *Grosvenor* does not appear to teach "monitoring" at the first user's camera **20** for a "presence signal" from a potential bondable device as recited in Claim 14. The Examiner's Answer cites paragraph 0055 of *Grosvenor* as disclosing such monitoring. Paragraph 0055 states

> ". . . the first user's camera is initially in an unsynchronised state (S1). The camera
> is prepared to accept input to cause it to undergo a synchronisation event, which
> would result in the camera being synchronised with other compatible cameras
> present at the event, and ultimately the users' collective photographs being made
> available for sharing via the repository provided in accordance with the present
> invention. In a preferred embodiment of the invention this synchronisation event
> would be initiated by this first camera itself, although it may alternatively be
> generated by a third party such as the management of the football stadium or
> theme park at which the common event is taking place. Remote third party
> initiation of the synchronisation event is preferred if the individual photographers
> are unlikely or unable to meet up in person, for example, at a large football match
> or a concert."

Restating, paragraph 0055 of *Grosvenor* indicates that the first user's camera can receive input either at the camera itself or from a third party, the input acting to unilaterally initiate the synchronization process between separate cameras. This is different from "monitoring an area of interest for the presence of potential bondable devices" as recited in Claim 14.

Relatedly, it appears that *Grosvenor* does not teach "receiving, at the master device, a presence signal from a potential bondable device" as also recited by Claim 14. The Examiner's Answer cites paragraph 0056 of *Grosvenor* as teaching this aspect, this paragraph reading

> "In the preferred embodiment of the invention the first camera user takes
> action (E1) himself to create an event identification code (an 'Event ID'), in
> readiness for subsequently synchronising his camera with other cameras in a
> synchronisation event. The Event ID may be created with the prior knowledge of
> the users of the compatible cameras with whom the first user intends to
> synchronise his camera and ultimately to share his photographs, or may be
> initiated with a view to the others subsequently synchronising their cameras with
> his."

However, the above passage from *Grosvenor* appears to be unrelated to a "presence signal." The "Event ID" of *Grosvenor* is simply an identifier that is created by the "first user" whose camera will be synchronized with other cameras that may or may not be identified at the time the Event ID is created.

For at least these reasons, Applicants respectfully submit that Claim 14, and the claims depending therefrom, are patentable over *Grosvenor*.

III. Rejections Under Section 103

A. Independent Claim 1

With regard to independent Claim 1, which stands rejected as being obvious over *Grosvenor* in view of *Burr*, the Examiner states (in both the final Official Action and the Examiner's Answer) that the recitation of "a digital device . . . [executing] a media transfer application code . . . for providing media file transfer parameters, the parameters including instructions to communicate captured media files with a specified set of metadata included in the communication" is taught by paragraph 0067 of *Grosvenor*.

Paragraph 0067 reads as follows:

> "As alluded to above in the context of tagging a photograph with the time at which it was taken, it is advantageous for the digital camera to assign a reference code to each of the photographs that has been taken. This code is transmitted with the photograph to the repository. In the preferred embodiment of the invention, the time of taking a photograph is included in its picture reference code. Camera-specific information to enable the identification of the camera (and hence the photographer) that took each photograph is also advantageously included. This information is then utilised by the repository to catalogue the pictures taken at the common event, and also to allow users, on accessing the repository, to view the pictures taken in chronological sequence irrespective of the photographer, or in terms of the identity of the photographer, or in a sequence dependent on both these parameters."

As such, paragraph 0067 of *Grosvenor* discusses digital cameras and a repository. However, paragraph 0067 of *Grosvenor* does not teach that either of these devices provides "instructions to communicate captured media files with a specified set of metadata included in the communication," as recited in Claim 1. Instead, paragraph 0067 indicates that the digital camera simply provides pictures and associated metadata, and not <u>instructions</u> regarding the provision of pictures and metadata.

For at least these reasons, Applicants respectfully submit that Claim 1, and the claims depending therefrom, are patentable over *Grosvenor* and *Burr*, taken either alone or in combination.

B. Independent Claim 24

Independent Claim 24 reads as follows:

> 24. A method for communicating media files and associated media file metadata from a bonded device to a master device, the method comprising:

>> bonding one or more slave devices to a master device according to predetermined media file transfer parameters communicated to the slave device from the master device; and
>> communicating a plurality of media files from the one or more bonded devices to the master device, the plurality of media files having metadata information as defined by the predetermined media file transfer parameters.

The Examiner indicated (in both the final Official Action and the Examiner's Answer) that the recitation of "communicating a plurality of media files from the one or more bonded devices to the master device, the plurality of media files having metadata information as defined by the predetermined media file transfer parameters" is disclosed in paragraph 0067 of *Grosvenor*. Specifically, the Examiner appears to equate (p. 13 of the Examiner's Answer) "communicating a plurality of media files from the one or more bonded devices to the master device" to *Grosvenor's* "synchronize and transfer photographs with time taken to repository," and also "the plurality of media files having metadata information as defined by the predetermined media file transfer parameters" to *Grosvenor's* "picture and time taken stored as reference code."

Reading Claim 24 in its entirety, the "master device" must communicate media file transfer parameters to (potential) slave devices, bond to slave devices, and receive media files from the slave devices. Reviewing paragraph 0067 of *Grosvenor* (reproduced above with respect to discussion of Claim 1), neither the digital cameras nor the repository discussed in that passage have the capabilities sufficient to be a "master device," and therefore does not teach that media files are communicated to a master device. As such, paragraph 0067 does not teach "communicating a plurality of media files from the one or more bonded devices to the master device" as recited in Claim 24.

For at least these reasons, Applicants respectfully submit that Claim 24, and the claims depending therefrom, are patentable over *Grosvenor* and *Burr*, taken either alone or in combination.

C. Independent Claim 34

Independent Claim 34 reads as follows:

> 34.   A system for communicating media files and assembling a collection of associated media files, the system comprising:
>> a master device that monitors an environment for slave devices and includes:
>>> a processor that executes a bonding application code to bond the master device to one or more slave devices,
>>> a memory device in communication with the processor that stores metadata information related to one or more slave devices and the users of the one or more slave devices, and
>>> a computer program product comprising a computer-readable medium and computer-readable program instructions stored therein, the computer-readable program instructions comprising a media transfer application code that provides media file transfer parameters that include instructions for creation of media file metadata information; and
>>> one or more slave devices that are bonded to the master device by successful execution of the bonding application code, wherein the one or more slave devices capture media files and communicate the captured media files to one or more devices that include a processor and a computer program product comprising a computer-readable medium and computer-readable program instructions stored therein with the computer-readable program instructions comprising a media file collection application code for communicating the collection of media files to one or more devices.

The Examiner indicated (in both the final Official Action and the Examiner's Answer) that the recitation of "a master device that . . . includes . . . computer-readable program instructions comprising a media transfer application code that provides media file transfer parameters that include instructions for creation of media file metadata information" is taught by paragraph 0067 of *Grosvenor*. Reviewing paragraph 0067 of *Grosvenor* (reproduced above with respect to discussion of Claim 1), neither the digital cameras nor the repository discussed in that passage have the capability to provide "instructions comprising a media file collection application code for communicating the collection of media files to one or more devices," as recited in Claim 34. Instead, the cameras discussed in paragraph 0067 of *Grosvenor* simply transfer media files (and not <u>instructions</u>) to the respository.

For at least these reasons, Applicants respectfully submit that Claim 34, and the claims depending therefrom, are patentable over *Grosvenor* and *Burr*, taken either alone or in combination.

IV. Rejections Under Section 101

With regard to the rejection of Claims 14-33 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, the Examiner's Answer references the recitations

"communicating, from the master device to the bonded device, media file transfer parameters, including definition of the media file metadata that is to be included with a captured media file"; and

"communicating a plurality of media files from the one or more bonded devices to the master device, the plurality of media files having metadata information as defined by the predetermined media file transfer parameters"

and states that "the information is not even stored at the respective destination device, it is just communicated to the device." Based on this fact, the Examiner concludes that the claims at issue do not produce a tangible result.

In determining whether claims are directed to statutory subject matter, it is instructive to consider the decision in *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998). In State Street, the court was considering, amongst others, the following claim:

1.   A data processing system for managing a financial services configuration of a portfolio established as a partnership, each partner being one of a plurality of funds, comprising:
        (a) computer processor means for processing data;
        (b) storage means for storing data on a storage medium;
        (c) first means for initializing the storage medium;
        (d) second means for processing data regarding assets in the portfolio and each of the funds from a previous day and data regarding increases or decreases in each of the funds, [sic, funds'] assets and for allocating the percentage share that each fund holds in the portfolio;
        (e) third means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily incremental income, expenses, and net realized gain or loss for the portfolio and for allocating such data among each fund;

(f) fourth means for processing data regarding daily net unrealized gain or loss for the portfolio and for allocating such data among each fund; and

(g) fifth means for processing data regarding aggregate year-end income, expenses, and capital gain or loss for the portfolio and each of the funds.

The court held that "the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result' – a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, 149 F.3d at 1373. Later, the court specifically held that "claim 1 . . . produces a "useful, concrete, and tangible result." *State Street*, 149 F.3d at 1374.

It is important to note that the aspects on which the court relies in determining that claim 1 produces a useful, concrete, and tangible result, *i.e.*, a final share price momentarily fixed for recording and reporting purpose, are logically enabled by the claimed subject matter, but are not actually recited in the claim. As such, *State Street* indicates that a claim should be understood to produce a useful, concrete, and tangible result if that result would naturally flow from the claim, whether or not the result has been recited in the claim. As such, the recitations presented above (a similar recitation is present in Claim 31) should be sufficient to conclude that Claims 14-33 are directed to subject matter producing a tangible result.
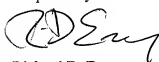
It is further noted that the concerns generally raised with respect to the patenting of pure ideas (*i.e.*, not directed to producing useful, concrete, and tangible results) are not applicable here. Specifically, in *Gottschalk v. Benson*, 409 U.S. 63 (1972), the Court noted that the claim at issue was for a method of converting binary-coded decimal numerals into pure binary numerals that was "not limited to any particular art or technology, to any particular apparatus or machinery, or to any particular end use." Since the claim would therefore "wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself," the Court concluded that the claim was unpatentable because its "practical effect" was to "patent an idea" in the abstract. *Benson*, 409 U.S. at 71-72. However, in the present case, the claims at issue do not monopolize an underlying algorithm or natural phenomenon, but are limited to the practical situation of facilitating the transfer of media files and associated metadata.

For at least these reasons, Applicants respectfully submit that Claims 14-33 are directed to statutory subject matter.

Overall, for each of the above reasons, it is submitted that the remaining rejections of Claims 1-34, 36-53, 55, and 57-68 are erroneous and reversal of these rejections is respectfully requested.

Respectfully submitted,

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